

Application No. 10/635,821
Response to Office Action

Customer No. 01933

R E M A R K S

Reconsideration of this application, as amended, is respectfully requested.

ALLOWABLE SUBJECT MATTER

The Examiner's indication of the allowability of the subject matter of claims 11 and 12 is respectfully acknowledged.

Independent claims 1, 13, 17, 20, 23, 25, 29, 32 and 35 have been amended to incorporate the allowable subject matter of claim 11.

In addition, claims 1, 2, 4-8, 13-23 and 25-35 have been amended to make some minor grammatical improvements and to correct some minor antecedent basis problems so as to put them in better form for issuance in a U.S. patent.

Still further, claims 25-35 have been amended to more clearly recite statutory subject matter. It is respectfully submitted that amended claims 25-35 now fully comply with the requirements of 35 USC 101, and it is respectfully requested that the rejection thereunder be withdrawn.

Yet still further, new independent claims 38, 40 and 41 have been prepared based on amended independent claims 1, 13 and 25, and to avoid unnecessary limitations of amended independent claims 1, 13 and 25.

Application No. 10/635,821
Response to Office Action

Customer No. 01933

And new claim 39 has been prepared to correspond to the subject matter of amended claim 12 depending from new independent claim 38.

No new matter has been added, and no new issues with respect to patentability have been raised.

Accordingly, it is respectfully requested that the amendments to claims 1, 2, 4-8, 13-23 and 25-35 and the addition of new claims 38-41 be approved and entered.

It is respectfully submitted, moreover, that amended independent claims 1, 13, 17, 20, 23, 25, 29, 32 and 35, new independent claims 38, 40 and 41, and claims 2, 4-8, 14-16, 18, 19, 21, 22, 26-28, 30, 31, 33, 34 and 39 respectively depending therefrom, are all in condition for immediate allowance.

RE: CLAIMS 9-12

Independent claim 9 has been amended to clarify the feature of the present invention whereby the macro-observation unit and the micro-observation unit are positioned at different positions, and whereby each comprises an optical system for observing the corresponding macroscopic or microscopic image. See Fig. 13 and the disclosure in the specification at, for example, page 35, line 19 to page 37, line 19.

In addition, claim 10 has been amended to clarify the feature of the present invention whereby each of the macro-

Application No. 10/635,821
Response to Office Action

Customer No. 01933

observation unit and the micro-observation unit comprises at least one of the illumination sources, and the operating means. See Fig. 13 and the disclosure in the specification at, for example, page 35, line 19 to page 37, line 19.

Still further, claims 9-12 have been amended to make some minor grammatical improvements and to correct some minor antecedent basis problems so as to put them in better form for issuance in a U.S. patent.

No new matter has been added, and it is respectfully requested that the amendments to claims 9-12 be approved and entered.

CLAIM FEE

The application was originally filed with 37 claims of which 13 were independent, and the appropriate claim fee was paid for such claims. The application now contains 38 claims, of which 13 are independent. Accordingly, a claim fee in the amount of \$50.00 for the addition of 1 extra claim in total is attached hereto. In addition, authorization is hereby given to charge any additional fees which may be required to Account No. 06-1378.

THE PRIOR ART REJECTION

Claims 9 and 10 were rejected under 35 USC 103 as being obvious in view of the combination of USP 6,434,264 ("Asar") and

Application No. 10/635,821
Response to Office Action

Customer No. 01933

USP 4,589,140 ("Bishop et al"). This rejection, however, is respectfully traversed with respect to claims 9 and 10 as amended hereinabove.

On page 9 of the Office Action, the Examiner acknowledges that Asar does not disclose both a macro-observation unit and a micro-observation unit in the manner of the present invention as recited in claim 9. For this reason, the Examiner has cited Bishop et al to supply the missing teaching of Asar.

It is respectfully pointed out, however, that Bishop et al merely discloses using a camera at the eyepiece of a microscope to scan an object at a variety of magnifications.

By contrast, according to the present invention as recited in amended independent claim 9, an image comparison apparatus is provided, which comprises, in particular: (a) a macro-observation unit including an optical system for observing a macroscopic observation image of a specimen; (b) a micro-observation unit which is disposed at a position different the macro-observation unit which and includes an optical system for observing a microscopic observation image of the specimen; and (c) a stage which moves the specimen between the macro-observation unit and the micro-observation unit.

That is, according to the present invention as recited in amended independent claim 9, the macro- and micro-observation units are provided separately and each comprises its own optical

Application No. 10/635,821
Response to Office Action

Customer No. 01933

system, and a stage is provided which moves the specimen between the separate macro- and micro-observation units.

It is respectfully submitted that capturing images of a specimen at different magnifications as disclosed by Bishop et al clearly does not at all correspond to the separate macro- and micro-observation units and stage recited in amended independent claim 9.

Accordingly, it is respectfully submitted that even if Asar and Bishop et al were combinable in the manner suggested by the Examiner, the present invention as recited in amended independent claim 9 still would not be achieved or rendered obvious.

In view of the foregoing, it is respectfully submitted that the present invention as recited in amended independent claim 9 and claim 10 depending therefrom clearly patentably distinguishes over the combination of Asar and Bishop et al under 35 USC 103, along with allowable claims 11 and 12 depending from claim 9 and along with allowable claims 1, 2, 4-8, 13-23 and 25-35.

* * * * *


Entry of this Amendment, allowance of the claims and the passing of this application to issue are respectfully solicited.

Application No. 10/635,821
Response to Office Action

Customer No. 01933

If the Examiner has any comments, questions, objections or recommendations, the Examiner is invited to telephone the undersigned for prompt action.

Respectfully submitted,


Douglas Holtz
Reg. No. 33,902

Frishauf, Holtz, Goodman & Chick, P.C.
220 Fifth Avenue - 16th Floor
New York, NY 10001-7708
Tel. No. (212) 319-4900
DH:al/iv
encs.